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APPLICATION NO.	FI	LING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/684,152		10/06/2000	Sean Hu	PSTM0034/MRK 9961	
29524	7590	04/05/2006	4	EXAMINER	
KHORSAN	IDI PATI	ENT LAW GROU	WEBB, JA	WEBB, JAMISUE A	
140 S. LAKE., SUITE 312 PASADENA, CA 91101-4710				ART UNIT	PAPER NUMBER
				3629	

DATE MAILED: 04/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

		Application No.	Applicant(s)			
	Office Action Summary	09/684,152 Examiner	HU ET AL.			
	•	Jamisue A. Webb	3629			
<del></del>	The MAILING DATE of this communication app	L				
Period fo			•			
WHIC - Exter after - If NO - Failur Any r	ORTENED STATUTORY PERIOD FOR REPLY CHEVER IS LONGER, FROM THE MAILING DATES and the sign of time may be available under the provisions of 37 CFR 1.13 SIX (6) MONTHS from the mailing date of this communication. Period for reply is specified above, the maximum statutory period were to reply within the set or extended period for reply will, by statute, eply received by the Office later than three months after the mailing and patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNICATION 36(a). In no event, however, may a reply be tir vill apply and will expire SIX (6) MONTHS from cause the application to become ABANDONE	N. nely filed the mailing date of this communication. D (35 U.S.C. § 133).			
Status						
1)🖂	Responsive to communication(s) filed on 09 Ja	nuary 2006.				
2a)□	This action is <b>FINAL</b> . 2b) This action is non-final.					
-	Since this application is in condition for allowance except for formal matters, prosecution as to the merits is					
	closed in accordance with the practice under E	x parte Quayle, 1935 C.D. 11, 49	53 O.G. 213.			
Dispositi	on of Claims					
5) 6) 7)	Claim(s) <u>5-24 and 26-55</u> is/are pending in the a 4a) Of the above claim(s) <u>21-24,36 and 37</u> is/are Claim(s) is/are allowed. Claim(s) is/are rejected. Claim(s) is/are objected to. Claim(s) <u>5-20,26-35 and 38-55</u> are subject to respect to the subject to t	e withdrawn from consideration.	ment.			
Applicati	on Papers					
10)	The specification is objected to by the Examiner The drawing(s) filed on is/are: a) acce Applicant may not request that any objection to the o Replacement drawing sheet(s) including the correcti The oath or declaration is objected to by the Ex-	epted or b) objected to by the drawing(s) be held in abeyance. Se ion is required if the drawing(s) is ob	e 37 CFR 1.85(a). jected to. See 37 CFR 1.121(d).			
Priority u	inder 35 U.S.C. § 119					
Priority under 35 U.S.C. § 119  12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  a) All b) Some colon None of:  1. Certified copies of the priority documents have been received.  2. Certified copies of the priority documents have been received in Application No.  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  * See the attached detailed Office action for a list of the certified copies not received.						
2) Notice 3) Inform	e of References Cited (PTO-892) e of Draftsperson's Patent Drawing Review (PTO-948) mation Disclosure Statement(s) (PTO-1449 or PTO/SB/08) r No(s)/Mail Date	4) Interview Summary Paper No(s)/Mail D 5) Notice of Informal F 6) Other:				

## **DETAILED ACTION**

## Election/Restrictions

- 1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 5, 6, 8-16, 18-20, 26-31, and 33-43, drawn to a method, system and computer program code for managing shipping for formatting and displaying a shipping label, classified in class 705, subclass 1.
  - II. Claims 7, 17, 32, and 44-55, drawn to a method system and computer program code for printing dimensionally accurate, classified in class 705, subclass 1.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because it does not require that the specific steps of sending a test image, receive a test image pattern indication, determining a set of graphic resolution characteristics based on the pattern indication, and generate an image to be printed. The subcombination has separate utility such as it can be used for other labels besides shipping labels, and it does not require the use of processing a request for shipping a parcel, and gathering information from a plurality of carriers.

The subcombination has utility in a system which is carrier specific, the combination, the system has rules for each carrier.

- 3. Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.
- 4. This application contains claims directed to the following patentably distinct species: If the Applicant elects Invention I, the following species exist and election is required:
  - a. Claims 5, 6, 8, 9, 15, 16, 18, 19, 30, 31, 33, 34 and 39 are drawn to one independent and distinct species; and
  - b. Claims 10, 11-14, 20, 26, 27, 30 and 40-42 are drawn to another independent and distinct species.

The species are independent or distinct because they are drawn to different embodiments of determining graphic resolution characteristics, species a, drawn to the method where the resolution corresponds to a display device, where as species a, sends a test image, and receives user input to determine the graphic resolution characteristics.

Description of the different embodiments are found in applicant's specification, pages 74 and 75.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 38 and 43 are generic.

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Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

5. After multiple amendments to the claims, the examiner feels the claims now recite numerous limitations, and are so detailed, that they are separating in scope, therefore the examiner is now requiring the restriction/election of species/

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In

either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Webb whose telephone number is (571) 272-6811. The examiner can normally be reached on M-F (7:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jamisue Webb
Patent Examiner
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